

REMARKS

Please enter the amendments to claims 1 and 15. Support for these amendments may be found in the specification at paragraph [0028]. No new matter is believed to have been added on entry of these amendments.

The following issues are outstanding in the present application:

- Claims 1-7 have been rejected under 35 U.S.C. 103(a);
- Claims 9 and 21-23 have been rejected under 35 U.S.C. 103(a);
- Claims 10-12 have been rejected under 35 U.S.C. 103(a);
- Claims 13 and 14 have been rejected under 35 U.S.C. 103(a); and
- Claims 15-18 have been rejected under 35 U.S.C. 103(a).

35 U.S.C. 103(a)

The Examiner has again rejected claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther. Applicant respectfully traverses the rejection:

Claim 1 as amended is patentable- The function of Oosterlinck and the function of Warther would both be destroyed in the combination proposed by the rejection. There is no motivation to combine the references, nor any reasonable expectation of success even if such a combination were attempted as Warther teaches away from making triangular-shaped tags

Oosterlinck teaches a device and method for preparing labels and attempts to overcome problems with label cutting/preparation techniques in the prior art by using a label cutting apparatus that converts a base stock into releaseably-lined labels by 1) separating a face web and a backing layer, 2) cutting a label from the face web while a vacuum roller holds the face web during the label cutting step (the shapes are unspecified), and 3) pressing the cut label back onto the backing liner to form the releaseably-lined labels: this process is said to be an improvement over the prior art, described at column 1, lines 18-39.

Warther, in contrast, is directed to a scored or perforated sheet, not a cut sheet, for

data storage tags. These scored sheets may or may not also embody additional scored rectangular or square-shaped “label” portions that when present may be additionally covered with an adhesive and a release layer for attachment to the tag. The sheet is made from a printable sheet material core having a pair of opposing major sides that may or may not be printed upon (Col. 7, lines 28-30). Both sides of the core are covered with a transparent film layer or web material that may be any material that is suitably and sufficiently transparent and can be applied to the core material without adversely affecting the core or the printing thereon (Col. 7, lines 61 and 62). The scored locations define the shape of the removable tags (and label portions if present) (Col. 3, lines 3-27). Further, Column 9, lines 46-57 states that if label portions are being scored, strips of pressure sensitive adhesive (PSA) 64 can be applied, with or without release paper 66, to the back side of one of the core surfaces under the label portion for the purpose of adhering them to the tags. See Fig. 2 where the pressure sensitive adhesive is applied to the two side edges of the back side of the labels. But notably, there is no teaching or suggestion of an adhesive layer or release paper covering the entire sheet, including the label portions. Nor are the label portions taught or suggested as being cut prior to applying the PSA and the release paper, just scored.

In summary, Oosterlinck only teaches a device and method for making cut-out labels, but suggests no particular shapes. Nor does he teach or suggest a scoring step. Warther teaches only a printed sheet product that may have numerous shapes, defined by scoring, which must be torn from the sheet to yield a shaped tag and optionally, a square or rectangular shaped label. Warther is silent as to how his scored sheets are made. Accordingly, Applicant respectfully suggests that these references are directed to unrelated fields of invention and thus not properly combinable.

In contrast to the cited references, Independent claim 1 is directed to an adhesive label produced by a process that includes the steps of: (1) providing a web consisting of an adhesive label substrate having a face material, an adhesive layer and a liner; (2) positioning the web in a label conversion machine wherein the web is continuously pulled through the conversion machine in a preselected web direction; (3) configuring a plurality of triangular shaped labels on the face material in which each label has a first, second and third side wherein the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width; (4) cutting the plurality of triangular shaped labels on the web to form a plurality of cut triangular

shaped labels; (5) printing the plurality of triangular labels; and (6) processing the plurality of triangular labels into individual rolled strips.

The 35 USC sec. 103 rejection of claim 1 over Oosterlinck, in view of Warther, essentially requires that one having ordinary skill in the art could know how to make the triangular labels according to claim 1 by taking the Warther teaching of a sheet product that is scored to define shaped tags and rectangular or square shaped labels, adding a pressure sensitive adhesive layer and a backing layer to the sheet to form a structure from which a separable label could be made; then separating the face layer from the backing layer, cutting a label shape, and reapplying the backing layer to the face layer, as described in Oosterlinck, to form the claimed releasably lined label. Further, one of skill in the art would have to know how to cut and form a plurality of triangular shaped labels that are oriented in a particular fashion relative to the sheet and to each other on the same sheet.

But the shaped tags of Warther are not formed from a face web, an adhesive layer and a backing/release layer, nor are they cut from a face web to form separate labels as required by Oosterlinck: Warther only teaches scoring sheets to define tags and optionally square or rectangular shaped labels. Only the rectangular label portion's edges are taught as optionally including an adhesive in conjunction with a removable backing layer. The entire sheet, including the tag, is never taught or suggested to be coverable with an adhesive layer and a backing layer. Accordingly, there would be no reason why one skilled in the art would attempt to combine the teachings in these references because Warther's scored sheets would then become a cutout label and Oosterlinck would be required to prepare a scored sheet product, neither of which are taught or suggested by either reference. Thus, the function of both references would be destroyed in the proposed combination. If a proposal for modifying a prior art reference, in an effort to attain a claimed invention, causes the reference to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *In re Gordon* 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed.Cir. 1984).

Further, Warther teaches scored sheets with numerous tag shapes only, including: "generally quadrilateral", "teardrops", "right triangles" and "isosceles triangles" – each of the latter two in associated quadrilateral shaped pairs. Warther further states that the tags could be other shapes. But at col. 7, line 15-21 he states:

“the triangular removable elements do not lend to easy subdivision of the sheet products...the more rectangularly arranged removable elements ...of sheet products respectively do lend to subdivision of the sheet products into smaller sheet products including at least one of the pairs of the removable elements...” emphasis added.

So, in contrast to the current rejection of claim 1, it is respectfully suggested that a person having ordinary skill in the art would know that Warther considers triangle shapes as difficult to remove from a scored sheet. Further, Warther prefers to make more rectangularly arranged removable elements that may be further broken apart into matched tags that can be triangular in shape (see col. 7., l. 15-21). Thus, given the variety of shapes disclosed in Warther, and the apparently unsolved problems in removing triangular- shaped pieces from a scored sheet, why would one of ordinary skill look to this reference for guidance into making a triangular-shaped label according to claim 1? In contrast to the unsupported rejection of claim 1, Applicant respectfully asserts that there is no teaching or suggestion found in Warther that would motivate one to combine the references in order to produce the invention of claim 1. Given the unsolved problems in removing triangularly shaped labels from a scored sheet, how can there any reasonable expectation of success for the combination proposed when the cited art clearly teaches away from the proposed combination.

Although the motivation stated in the current rejection may or may not be driving the inventors in the instant case, the only potential teaching for such motivation is clearly Applicants’ own patent application. Using Applicants’ own invention to supply the motivation for combining references is inappropriate. As stated in MPEP sec. 2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ 1430 (Fed.Cir. 1990). Accordingly, as there is no desirability for the proposed combination as described above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 1 under 35 U.S.C. 103(a) as having subject matter obvious over Oosterlinck in view of Warther.

35 U.S.C. 103(a)

If an independent claim is non-obvious under 35 U.S.C. § 103(a), then any claim depending therefrom is by definition non-obvious. *In re Fine*, 5 USPQ 2d. 1596 (Fed. Cir. 1988). Applicant respectfully submits that claims 2-7 depend at least in part from amended

independent claim 1 and therefore are non-obvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over Oosterlinck and Warther.

35 U.S.C. 103(a)

The Examiner has rejected claims 9, 21, and 23 under 35 U.S.C. 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, and further in view of Kirk and further in view of the specification at page 1, paragraph [0003]. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion regarding the patentability of the subject invention over the combination of Oosterlinck and Warther obviates the present rejection of these claims. Kirk nor paragraph [0003] in the specification add nothing to the Oosterlinck and Warther rejection that makes claim 1 obvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claim 9 depends at least in part from independent claim 1 and claims 21 and 23 depend at least in part from independent claim 15 (see discussion below concerning the patentability of claim 15). Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of Kirk and the specification at page 1, paragraph [0003] the rejection should be withdrawn.

35 U.S.C. 103(a)

The Examiner has rejected claims 10 and 12 under 35 U.S.C. 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, and further in view of the specification regarding printing color on the plurality of labels and the color related to an industry standard color code system. Applicant respectfully traverses.

Applicant respectfully submits that the previous discussion of the patentability of the subject invention over the combination of Oosterlinck and Warther obviates the present rejection of these claims. The discussion in the specification related to printing and color standards adds nothing to cure the deficiencies of the primary rejection. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claim 10 and 12

depend at least in part from independent claim 1. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003].

35 U.S.C. 103(a)

The Examiner has rejected claims 13 and 14 under 35 U.S.C. 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003]. Applicant respectfully traverses.

Applicant submits that the previous discussion of the patentability of the subject invention over the combination of Oosterlinck and Warther obviates the present rejection of these claims. The disclosure in paragraph [0003] adds nothing to cure the deficient rejection of claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claim 13 and 14 depend at least in part from independent claim 1. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003].

35 U.S.C. 103(a)

The Examiner has newly rejected claims 15-18 under 35 U.S.C. 103(a) as having subject matter unpatentable over Oosterlinck in view of Warther, further in view of Kirk and in further view of the description in the specification on page 1 at paragraph [0003].

With respect to independent claim 15, Applicant respectfully traverses the rejection in part based on the previous discussion(s) of the rejection of Oosterlinck in view of Warther in regards to claim 1, further in view of Kirk, further in view of the description in the specification at page 1, paragraph [0003]; and for the additional following reasons: As the Action correctly notes, neither Oosterlinck, Warther, nor Kirk, teach or suggest a triangular shaped label that has sides of equal length that is also covered with a adhesive layer. The only teaching or suggestion of any remotely triangular shape is the tags (not the labels) in Warther and those are described as “generally isosceles” or “right triangular”, in which they preferably occur in matched pairs that resemble rectangles, but never are triangles with sides of equal length taught or suggested, nor are these tags taught or suggested as being entirely covered by an adhesive layer.

What Warther does teach is increasing the number of tags by excluding the label portions from a sheet. But there is no suggestion or teaching related to changing or modifying the shapes of the “generally isosceles” triangles to any other shape with the exception that *rectangular shapes* are preferred, as discussed above.

Since none of the references teach or suggest the line of reasoning proffered in regards to making claim 15 obvious, the Examiner must be relying on prior art within his own knowledge. As stated in M.P.E.P. sec. 2144.03, if the Examiner relies on personal knowledge, Applicant is entitled to an affidavit by the Examiner, so that the Applicant can refute with specificity the Examiner’s assertion.

Accordingly, Applicant requests reconsideration of claim 15 and that the Examiner withdraw the sec. 103 rejection based on the cited combination and the Examiner’s personal knowledge, or provide a affidavit in compliance with M.P.E.P. sec. 2144.03.

With regard to the rejection of dependent claims 16-18, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claims 16-18 depend at least in part from independent claim 15. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003] and the Examiner’s line of reasoning in the current Official Action.

With regard to the rejection of dependent claims 21 and 23, Applicant refers the Examiner back to the previous discussion regarding the patentability of claim 1 and the above additional discussion overcoming the rejection of claim 15. Claims 21 and 23 depend at least in part from independent claim 15. Applicant asserts that because these are dependent claims, they are nonobvious over Oosterlinck in view of Warther, and further in view of the specification at page 1, paragraph [0003] and the Examiner’s reasoning in the Official Action. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988).

Applicant respectfully submits that this application is now in condition for allowance. In the event that minor claim amendments are necessary to meet formal requirements, Applicant invites the Examiner to telephone the undersigned so that appropriate amendments can be made.

Respectfully submitted,

By: _____

Jan K. Simpson

Registration No. 33,283

Date: 6-11-03

FULBRIGHT & JAWORSKI, LLP
1301 McKinney
Suite 5100
Houston, Texas 77010
Telephone No.: (713) 651-5151
Facsimile No. : (713) 651-5246

CERTIFICATE UNDER 37 C.F.R. § 1.8(A)

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail ER 065890589 US in an envelope addressed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231, on June 11, 2003.

Jan K. Simpson, Registration No. 33,283